

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein amendments and remarks, which place the application in condition for allowance.

Examiners Butler and Huson are kindly thanked for the many courtesies extended during the telephonic interview of June 25, 2008.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 3-19 and 22 are currently under consideration. Claim 2 is cancelled and claims 1, 9, 11, and 22 are amended without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Support for the amendment to claim 1 can be found throughout the specification as filed, for example, on page 4, lines 13-29, on page 5, lines 10-16, on page 6, line 10 – page 7, line 10, and in Figure 6. Support for the amendment to claim 9 can be found on page 7, lines 18-23. The amendments of claims 11 and 22 are to perfect antecedent basis. No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicant is entitled.

II. THE REJECTION UNDER 35 U.S.C. § 112 IS OVERCOME

Written Description

Claim 9 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action contended that the phrase “polyester felt-like” material is not supported in the specification.

While Applicants disagree, solely to advance prosecution, Applicants have amended claim 9 to recite language that the Examiner conceded is supported in the specification. Hence, instant claim 9 recites “polyester fabric.” This should not be interpreted as acquiescence to or agreement with the rejection, and Applicants reserve the right to pursue the subject matter as

previously claimed in continuing applications. Reconsideration and withdrawal of the rejection are requested.

Clarity

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particular point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action asserted that the recitation of “polyester felt” in claim 9 is unclear, because this element is allegedly not disclosed in the specification and therefore the scope of the claim is unascertainable.

While Applicants disagree, solely to advance prosecution, Applicants have amended claim 9 to recite language that the Examiner conceded will provide a clear scope of the invention. Hence, as described above, instant claim 9 recites “polyester fabric.” This should not be interpreted as acquiescence to or agreement with the rejection, and Applicants reserve the right to pursue the subject matter as previously claimed in continuing applications. Reconsideration and withdrawal of the rejection are requested.

III. THE REJECTIONS UNDER 35 U.S.C. § 102(b) ARE OVERCOME

Claims 1, 2, 5, 10, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano *et al.* (U.S. Patent No. 5,995,017; hereinafter “Foffano”). Claims 3 and 4 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano as evidenced by Smith (Textiles in Perspective, page 418). The Office Action maintained that Foffano relates to all elements of the present invention, and was not persuaded by Applicants’ previous arguments. These rejections are respectfully traversed and will be addressed collectively.

Initially, attention is drawn to the amended claims, wherein claim 1 clarifies that the method of the present invention relates to manufacturing a half-shell of a sports boot having an upper part and a sole in composite material from flat blanks, wherein the half shell forms either the lateral or medial side of the upper part and covers either the lateral or medial side of the wearer’s upper foot. The method comprises a first step of preparing a first flat blank in a first flexible material forming the external face of the half-shell, and a second flat blank in a second flexible material forming the internal face of the half-shell. A second step comprises providing a mold, which comprises a first half and a second half having a three-dimensional impression of

the half-shell. A third step comprises placing the first and second flat blanks on the impression of the first half of the mold, with the first blank against the impression. A fourth step comprises closing the mold by using the second half. A fifth step comprises injecting a foamable binding material between the blanks, wherein the blanks conform to the shape of the mold. Finally, a sixth step comprises mold releasing after polymerization of the injected material so as to obtain the half-shell comprising the first and second blanks conformed to the mold of the three-dimensional impression of the half-shell.

With this in mind, it is clear that Foffano does not teach each and every limitation of the instant claims. Firstly, Foffano does not relate to a method of manufacturing a part of the upper of a sports boot; instead Foffano relates to forming a sole for shoes.

Secondly, Foffano does not teach a first and second flat blank as recited in the first step of claim 1. The alleged “blanks” of Foffano (sole “4” and upper “2”) are clearly not flat, as the sole “4” has a ridge which “protrudes perimetricaly and downwards with respect to the ground resting plane (i.e. lower surface) of the sole” (see col. 2, line 64 – col. 3, line 2, of Foffano), and the upper “2” clearly curves around the adapted last 13 (see Figures 1-12 of Foffano). Therefore, these blanks in Foffano are not flat.

Thirdly, Foffano does not teach blanks that conform to the shape of the mold as recited in the fifth step of claim 1. As clearly seen in Figures 1-12 of Foffano, the sole “4” and upper “2” have not conformed to the shape of the mold, as these components undergo no changes during the molding process.

For these reasons, it is clear that Foffano does not teach all elements of claim 1, and consequently does not teach all elements of dependent claims 2-5, 10, and 22. Further, Smith, which was cited against claims 3 and 4, does not remedy these deficiencies in Foffano. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) are respectfully requested.

IV. THE REJECTIONS UNDER 35 U.S.C. § 103(a) ARE OVERCOME

Claim 6 was rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Dassler (U.S. Patent No. 4,187,623). Claims 7 and 9 was rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Huebner *et al.* (German Patent Document

No. DE 19512499C1; hereinafter "Huebner"). Also, claim 8 was rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Legassie *et al.* (U.S. Patent No. 5,343,638; hereinafter "Legassie"). Claims 11 and 12 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Brehmer *et al.* (U.S. Patent No. 4,793,882). Claims 11, 13-15, and 17 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 4,428,130; hereinafter "Perotto '130"). Finally, claims 11, 16, and 19 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 5,050,319; hereinafter "Perotto '319"). These rejections are respectfully traversed and will be addressed collectively.

Again, it is noted that claim 1 is amended to clarify that the method of the invention relates to manufacturing a half-shell which forms either the lateral or medial side of the upper part of a sports boot. The method comprises preparing a first flat blank and a second flat blank to form the external and internal face, respectively, of the half-shell. The method also involves providing a mold having a three-dimensional impression of the half shell, wherein the blanks conform to the shape of the mold. Notably, all dependent claims incorporate these elements.

As asserted above, Foffano does not teach or suggest that the alleged blanks in Foffano will form a half-shell of the upper part of a boot, or that the blanks are flat, or that the blanks conform to the shape of the mold. Moreover, the combination of Foffano with the other cited references also do not render the rejected claims unpatentable. Dassler relates to a sports shoe and is cited for the purpose of allegedly disclosing a thickness range for the rubber sole. Huebner relates to a shoe with a cap in the toe region and was cited for allegedly disclosing polyester felt in the shoe. Legassie relates to a shoe comprising chambers, and was cited for its alleged disclosure of using elastic fabric in the shoe. Brehmer relates to a process of screen printing on shoes. Further, Perotto '130 was cited because it allegedly relates to a method of affixing an eyelet element to an upper before assembly. Perotto '319 allegedly relates to attaching a tongue to an inner lining in a boot. Clearly, none of the references remedy the deficiencies in Foffano, *i.e.*, these references do not teach or suggest blanks which form a half-shell that relates to the upper part of the boot, do not teach blanks that are flat, and do not teach blanks that conform to the shape of the mold.

Further, there is no teaching or suggestion in any of the cited references to lead one skilled in the art to try and apply the methods of manufacturing a sole to manufacturing an upper

part of the boot, or to conform the blanks, *i.e.*, the sole "4" and the upper "2," to the shape of the mold.

Thus, none of the combinations of references render the present invention unpatentable. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

A handwritten signature in black ink, appearing to read "Ronald R. Santucci", written over a horizontal line.

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